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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,805	10/19/2001	Henry Colombo	CSA-101-B	9375

7590 01/12/2005

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EXAMINER

DUNWOODY, AARON M

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/039,805

Applicant(s)

COLOMBO ET AL.

Examiner

Aaron M Dunwoody

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-14, 25-27, 29 and 30 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 12-14, 25-27, 29 and 30 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-14, 25-27, 29 and 30 are rejected under 35 U.S.C. 103(a) as being patentable over US patent 5316352, Smith in view of 3M VMB™ Double Coated Acrylic Foam Tapes and Adhesive Transfer Tapes Technical Data, European patent EP 0095915 A1, Cook, and US patent 5961154, Williams et al.

In regards to claim 12, Smith discloses a sealer joint comprising a pair of adjacent thin wall metallic pipes (20) having smooth interior and exterior surfaces and end portions, each end portion having a squared cut terminal end and a rounded cross-sectional configuration, wherein a pair of the pipe squared cut terminal ends of the adjacent pipes positioned in a parallel and an end to end relationship to each other, and wherein the pair of the pipe squared cut terminal ends essentially abut each other (see Figures 8 and 17); and a strip of tape (26) wherein a portion of the strip is applied around and over the exterior surfaces of each of the abutting pipe squared cut terminal ends (col. 3, lines 60-62), and wherein the strip of tape has a first end and a second end.

Smith does not disclose a double-sided adhesive, closed-cell acrylic foam tape. Smith does disclose duct tape (col. 3, lines 60-62). 3M VMB™ Double Coated Acrylic

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Foam Tapes and Adhesive Transfer Tapes Technical Data teaches a double-side adhesive, closed-cell acrylic foam tape ideal for use in many exterior industrial applications which can replace liquid adhesives (such as the duct tape of Smith), and is ideal for bonding a variety of substances, including most metals (pg. 1, lines 4-12).

Further, Cook is evidence that it is commonly known in the art to apply a tape (T) having first and second ends forming an overlap over the first end and contacts the first end "to improve the seal formed between the ends of the wrapping tape" (pg. 1, lines 20-21).

It would have obvious to one having ordinary skill in the art at the time the invention was made to provide a double-sided adhesive, closed-cell acrylic foam tape and overlap the tape ends, since Smith discloses duct tape; 3M VMBTM Double Coated Acrylic Foam Tapes and Adhesive Transfer Tapes Technical Data teaches a double-side adhesive, closed-cell acrylic foam tape ideal for use in many exterior industrial applications which can replace duct tape, and is ideal for bonding a variety of substances, including most metals; and Cook is evidence that it is commonly known in the art to apply a tape (T) having first and second ends forming an overlap over the first end and contacts the first end to improve the seal formed between the ends of the wrapping tape.

Smith does not disclose a coupling. Williams et al teaches a coupling (20) to provide a device which can easily and quickly affixed to a joint between two tubular section (col. 3, lines 42-44). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a coupling (20) to provide a device

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which can easily and quickly affixed to a joint between two tubular section, as taught by William et al.

In regards to claim 13, Smith in view of 3M VMB™ Double Coated Acrylic Foam Tapes and Adhesive Transfer Tapes Technical Data, European patent EP 0095915 A1, Cook and Williams et al disclose the coupling having clampable ends and wherein clampable ends are positioned and secured together of the double-sided adhesive, closed-cell acrylic foam tape.

In regards to claim 14, Smith in view of 3M VMB™ Double Coated Acrylic Foam Tapes and Adhesive Transfer Tapes Technical Data, European patent EP 0095915 A1, Cook and Williams et al disclose the pair of abutting pipe squared cut terminal ends being butted as close together as possible and a portion of the strip of double-side adhesive, closed cell acrylic foam tape being secured to the exterior surfaces of each of the adjacent pipe for providing a sealed joint.

In regards to claim 25, Smith in view of 3M VMB™ Double Coated Acrylic Foam Tapes and Adhesive Transfer Tapes Technical Data, European patent EP 0095915 A1, Cook and Williams et al disclose a sealed joint comprising:

a pair of thin wall metallic pipes having axial lengths with smooth interior and exterior surfaces along the entire axial lengths, each pipe having extremities, wherein each pipe is positioned in a parallel and an end-to-end relationship to each other forming abutting extremities;

a double-sided adhesive, closed-cell acrylic foam tape having a normal tensile strength of at least 80 - 1101bs./in² to aluminum at room temperature, wherein a portion

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of the double-sided adhesive, closed-cell acrylic foam tape is wrapped around the exterior surfaces of each of the abutting extremities for providing a leakproof joint and a smooth interior surface at the joint;

and a coupling having clampable ends, clamped and secured together over the double-sided adhesive, closed-cell acrylic foam tape.

In regards to claim 26, Smith in view of 3M VMB™ Double Coated Acrylic Foam Tapes and Adhesive Transfer Tapes Technical Data, European patent EP 0095915 A1, Cook and Williams et al disclose the claimed invention except for the double-sided adhesive, closed-cell acrylic foam tape being precut so that a second end of the precut tape overlaps over and contacts a first end of the precut tape around the pipe extremities forming an overlap approximately 3/16" - 1/4" long and at least one of the clampable ends having a tongue extending therefrom, wherein the tongue is positioned directly over the overlap. It would have been an obvious matter of design choice to fabricate the double-sided adhesive, closed-cell acrylic foam tape precut so that a second end of the precut tape overlaps a first end of the precut tape around the pipe ends forming an overlap approximately 3/16" - 1/4" long and the coupling having a clamping means positioned over the overlap, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Note, a comparison of the recited process with the prior art processes does NOT serve to resolve the issue concerning patentability of the product. In re Fessman, 489

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F2d 742, 180 U.S.P.Q. 324 (CCPA 1974). Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable. In re Klug, 333 F2d 905, 142 U.S.P.Q. 161 (CCPA 1964). In an ex parte case, product-by-process claims are not construed as being limited to the product formed by the specific process recited. In re Hirao et al., 535 F2d 67, 190 U.S.P.Q. 15, see footnote 3 (CCPA 1976). Therefore, the double-sided adhesive, closed-cell acrylic foam tape being precut so that a second end of the precut tape overlaps a first end of the precut tape around the pipe ends forming an overlap approximately 3/16" - 1/4" long is given little patentable weight.

In regards to claim 27, Smith in view of 3M VMB™ Double Coated Acrylic Foam Tapes and Adhesive Transfer Tapes Technical Data, European patent EP 0095915 A1, Cook and Williams et al disclose the double-sided adhesive, closed-cell acrylic foam tape further providing a static sheer of at least 1000 grams at 72° and 500 grams at 150°F, has a peel adhesion rating for stainless steel at room temperature of at least 181bs./in.

In regards to claim 29, Smith in view of 3M VMB™ Double Coated Acrylic Foam Tapes and Adhesive Transfer Tapes Technical Data, European patent EP 0095915 A1, Cook and Williams et al disclose the double-sided adhesive, closed cell acrylic foam tape applied on the pair of pipe extremities at a temperature as low as 32°F.

In regards to claim 30, Smith in view of 3M VMB™ Double Coated Acrylic Foam Tapes and Adhesive Transfer Tapes Technical Data, European patent EP 0095915 A1, Cook and Williams et al disclose a sealed joint comprising:

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a pair of metallic pipes having smooth interior and exterior surfaces, the pair of metallic pipes each having a terminal end abutted in an end-to-end relationship to each other;

a double-sided adhesive, closed-cell acrylic foam tape applied around the exterior surfaces of each of the abutted terminal ends, wherein the adhesive foam tape has an axial length and the axial length of the tape is positioned essentially parallel to the abutting terminal ends, and wherein the adhesive foam tape has one end overlapping and secured to an opposing end of the tape forming an overlap; and

a coupling clamped over the acrylic foam tape, wherein the coupling has a pair of clampable ends secured together and tightened over the overlap of the tape and wherein the double-sided adhesive, closed-cell acrylic foam tape having the following properties: a peel adhesion rating of at least 181bs/in² at room temperature for stainless steel, a normal tensile strength to aluminum at room temperature of at least 501bs./in², a static sheer of at least 1000 grams at 72°F and of at least 500 grams at 150°F, a dynamic sheer of 40 lbs./in², a static sheer of 250 grams for 10,000 minutes and a temperature tolerance of at least 160°F.

Response to Arguments

Applicant's arguments with respect to claims above have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron M Dunwoody whose telephone number is 703-306-3436. The examiner can normally be reached on 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P Stodola can be reached on 703-306-5771. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Aaron M Dunwoody
Examiner
Art Unit 3679

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